

## REMARKS

1. In response to § 101 rejections for claim 9, Applicant has amended claim 9 as discussed with Examiner Tiv on January 17, 2008, wherein Examiner Tiv and Applicant agreed that such a claim amendment would remove the basis for § 101 rejection for claim 9. Withdraw of the § 101 rejection for claims 9 is resentfully requested.

In response to § 101 rejections for claims 20-35 of the Office Action, Applicant amends original paragraph [0059] of the specification as discussed with Examiner Tiv on January 17, 2008, wherein Examiner Tiv and Applicant agreed that such an amendment to original paragraph [0059] would remove the bases for § 101 rejections for claims 20-35. Accordingly, Applicant respectfully requests that the original paragraph [0059] be deleted and replaced with paragraph [0059] in this Response. Withdraw of the § 101 rejections for claims 20-35 is resentfully requested.

2. Applicant acknowledges the Examiner's citation to U.S. Pat. No. 6,606,709 issued to Connery *et al.* ("Connery") in view of U.S. Pat. No. 6,732,267 issued to Wu *et al.* ("Wu") as forming the basis for the Office Action's rejection of Applicant's claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35 under 35 U.S.C. § 103 (a). Applicant objects with traverse to Connery in view of Wu rendering obvious Applicant's claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). "While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation test in an obviousness inquiry, the Court acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination."<sup>1</sup> The *prima facie* case of obviousness still requires: 1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, 2) that the references possess a reasonable expectation of success in the modification or combination, and 3) that the references must teach or suggest

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<sup>1</sup> *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, \*12-13 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. at 1731 (2007)).

all of Applicant's claim elements and limitations.<sup>2</sup> Below, Applicant shows that Connery in view of Wu fails to make obvious any of Applicant's claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35.

First, Connery in view of Wu fails to render obvious any of Applicant's independent claims, namely claims 1, 9, 12, 20, 23 and 28, because no suggestion or motivation exists or is shown otherwise for one to modify these references to arrive at Applicant's claimed invention in its independent claims.<sup>3</sup> The Office Action does not contend, and Applicant agrees, that such a suggestion or motivation exists in the references. In fact, Connery never even mentions BIOS and Wu never even mentions wake-on-LAN ("WOL") packets, much less modified-WOLs that comprising executable code; further, the Office Action implicitly admits these facts in its statements of what Connery and Wu are alleged to teach at page 4 of the Office Action. However, the Office Action does conclude that one of ordinary skill in the art would combine Connery and Wu to render obvious Applicant's independent claims. Applicant disagrees and respectfully submits that there is no reasoning to support this conclusion by the Office. Notably, this lack of reasoning to support the conclusion of obviousness is counter to established obviousness law and the recent *KSR* decision. Specifically, the *KSR* Court acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination.<sup>4</sup> Instead, Applicant respectfully submits that the Office's conclusion of obviousness is impermissibly founded on hindsight, wherein the court said in *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, "to imbue one of ordinary skill in the art with knowledge of the Applicant's invention, when the prior art does not teach or suggest the relevant knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher," *i.e.*, the inventor.<sup>5</sup> Accordingly, since Applicant has shown that there is no suggestion or motivation exists in Connery, Wu or otherwise to combine these references to render obvious any of

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<sup>2</sup> MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

<sup>3</sup> *Id.*

<sup>4</sup> *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, \*12-13 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. at 1731 (2007)).

<sup>5</sup> *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Applicant's independent claims 1, 9, 12, 20, 23 and 28, then none of Applicant's independent claims, or any claims depending therefrom, are obvious as a matter of law.<sup>6</sup> Withdraw of the obviousness rejections as to claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35 is respectfully requested.

Second, Connery in view of Wu fails to render obvious any of Applicant's independent claims, namely claims 1, 9, 12, 20, 23 and 28 because Connery in view of Wu does not teach or suggest all of Applicant's claim elements and limitations in these independent claims.<sup>7</sup> Applicant agrees with the Office in that Wu does not teach Applicant's first claim element and its limitations and Connery does not teach Applicant's second, third and fourth claim elements and its limitations in claim 1. Regarding Wu specifically, however, Applicant disagrees that it teaches Applicant's second, third and fourth claim elements and its limitations in claim 1. At the Office Action's cited sections of Wu, namely its Abstract and col. 2, ll.19-36, Wu discusses "updating a system BIOS" "by storing the updated BIOS" etc. Applicant's claimed invention, however, is not focused on updating BIOS or storing an updated BIOS like Wu. Instead, Applicant's claimed invention uses the BIOS to achieve an end, i.e., to retrieve and process executable code found in a modified-WOL that is stored in memory associated with the network receive buffer. Consequently, although Wu discusses updating and storing the updated BIOS, it has no relation to Applicant's invention as found at claim 1, and, in particular, fails to teach or suggest Applicant's second, third, and fourth claim elements and their limitations. Furthermore, and using the same rationale as the Office does at the bottom of page 5 of the Office Action, Wu, even in view of Connery, also fails to teach or suggest all of the claim elements and limitations of Applicant's other independent claims 9, 12, 20, 23 and 28. Accordingly, since Applicant has shown that Connery in view of Wu fails to render obvious any of Applicant's independent claims 1, 9, 12, 20, 23 and 28 because they do not teach or suggest all their elements and limitations, then none of Applicant's independent claims, or any claims depending therefrom, are obvious as a matter

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<sup>6</sup> *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

<sup>7</sup> MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

of law.<sup>8</sup> Withdraw of the obviousness rejections as to claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35 is respectfully requested.

3. Applicant acknowledges the Examiner's citation to Connery in view of Wu and further in view of U.S. Pat. No. 6,542,979 issued to Eckardt ("Eckardt") as forming the basis for the Office Action's rejection of Applicant's claims 4, 5, 7, 16-18, 25-27, and 32-34 under 35 U.S.C. § 103 (a). Applicant objects with traverse to Connery in view of Wu and further in view of Eckardt rendering obvious Applicant's claims 1-3, 6, 8, 9-15, 19-24, 28-31, and 35. As previously shown under this Response's section 3, since Clifford in view of Wu does not render obvious any of Applicant's independent claims, then none of the dependant claims, namely claims 4, 5, 7, 16-18, 25-27, and 32-34, can be deemed obvious as a matter of law even in view of Eckardt.<sup>9</sup> Based on such, withdraw of the obviousness rejections as to dependent claims 4, 5, 7, 16-18, 25-27, and 32-34 is respectfully requested.

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<sup>8</sup> *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

<sup>9</sup> *Id.*

## **CONCLUSION**

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney at the contact information found in the signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 50-3533 for any such required fee.

Respectfully submitted,

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